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09/740,618	12/18/2000	James M. Barton	TIVO0064	9889

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EXAMINER
MA, JOHNNY

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/740,618	BARTON, JAMES M.	
	Examiner	Art Unit	
	Johnny Ma	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 14-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 14-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/05,2/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/27/2005 regarding claims 1-4 have been fully considered but they are not persuasive. Applicant argues that "Gale teaches away from what is claimed in Claim 4 by teaching that an advertisement is physically split into two 15 second spots. This is not what is claimed in Claim 4. Claim 4 cites that a beginning portion and/or end portion is designated in a television advertisement." The examiner respectfully disagrees. It is noted that "designate" is defined as "1: to indicate and set apart for a specific purpose, office, or duty...2 a: to point out the location of" as defined in Merriam-Webster's Collegiate Dictionary (10th Edition). Also note, MPEP § 2111.01:

> If more than one extrinsic definition is consistent with the use of the words in the intrinsic record, the claim terms may be construed to encompass all consistent meanings. Tex. Digital, 308 F.3d at 1203, 64 USPQ2d at 1819. See also< Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001)(explaining the court's analytical process for determining the meaning of disputed claim terms); Toro Co. v. White Consol. Indus., Inc., 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999)("[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning.").

As discussed in the previous rejection, the Gales article discloses a bookend strategy for advertising. The Gale article discloses "[t]he first half [of the advertisement] is followed by a separate, unrelated commercial so that the viewer has to wait for the second half to see what happens to the sufferer (see Excedrin Commercial Spot." Thus the Gale article discloses taking a single advertisement and splitting the advertisement into two portions, as discussed in the previous Office Action. Such splitting of the single advertisement "designates" a beginning and

end portion of the advertisement in that the splitting indicates and sets apart the advertisement portions for a specific purpose. Thus the examiner respectfully submits that in regard to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pointing out the locations of the beginning and end portion of an advertisement without splitting the advertisement) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by the Gales Article: "Creatives find 'Bookends' a Solution to Viewer Apathy."

As to claim 4, note the Gales article that discloses creatives find 'bookends' a solution to viewer apathy. The claimed "designating a beginning portion and end portion of a television advertisement; "wherein each portion is of a predetermined length of time" is met by the bookending comprising splitting of an advertisement into two 15 second spots (see Excedrin Commercial Spot). The claimed "wherein said beginning portion and said end portion contain more important content designed to get a desired message across to the viewer in the predetermined length of time" is met by wherein the beginning portion of the advertisement

conveys a actor with a headache and the end portion signifying the advertised product as the solution to the actor's headache (see Excedrin Commercial Spot).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gales Article: "Creatives find 'Bookends' a Solution to Viewer Apathy in further view of Automotive News: Audi Ads focus on technology.

As to claim 1, note the Gales article that discloses creatives find 'bookends' a solution to viewer apathy. The claimed "designating a commercial break in a program segment" is met by "[a]n example of bookend commercials is this Excedrin spot by DDB Needham/New York, left and right, in which the actor appears in the firs 15-second pod stricken by a headache" "and then the product's benefit is shown in the second 15 seconds to signify it as being the solution to the actor's headache" (see Excedrin Commercial Spot). The claimed "wherein each portion is of a predetermined length of time" is met by the partitioning of the commercial into 15 second spots (see Excedrin Commercial Spot). The claimed "wherein said beginning portion and end portion are authored to provide a teaser to entice a viewer to watch commercials during the break" is met by "[t]he first half is followed by a separate, unrelated commercial so that the viewer has to wait for the second half to see what happens to the sufferer" (see Excedrin Commercial Spot)

However the Gales article is silent as to partitioning the beginning and end of the commercial spot. Now note the Audi article that discloses "'bookends' at the beginning and end of commercial breaks" (see Audi, paragraph 2). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gales bookending with the Audi bookend at the beginning and end of a commercial break for the purpose of encouraging users to watch the entire commercial break in order to view the conclusion of the first 15 second segment.

As to claim 2, the claimed "wherein said teaser is a set of images or a logo that indicate a commercial relating to a particular advertiser is present" is met by that discussed in the rejection of claim 1 wherein the video advertisements inherently comprise a set of images.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gales Article: "Creatives find 'Bookends' a Solution to Viewer Apathy in further view of Automotive News: Audi Ads focus on technology and Balakrishnan et al. (US 2001/0052135 A1).

As to claim 3, the claimed "wherein said teaser is a menu or short sequence of animations designed to catch the viewer's attention and persuade him to watch the commercial break." Note the Gales Article discloses the use of bookended advertisement teasers to encourage users to watch a commercial break (see Excedrin Commercial Spot). The Gales Article also discloses "'[t]he [bookend] strategy is probably based on sound principles,' said Betsy Frank, senior vp/associate director of media research for Saatchi & Saatchi Advertising, 'that the more you can involve viewers in an interactive way with commercials, it gets them interested enough to stay with what is being presented longer'" (Gales, see para. 3). However, the Gales Article does not specifically disclose "wherein said teaser is a menu or short sequence of animations." Now note

the Balakrishnan et al. reference that discloses a method and system for implementing interactive broadcast programs and commercials. The claimed "wherein said teaser is a menu or short sequence of animations" is met by "at the time of a commercial break in the main program being broadcast over the broadcast channel which is currently selected by the viewer, a choice (or menu) or different commercials which are available to the viewer will be displayed. For example, several different logos or video sequences can be displayed on different portions or spatial locations of the display area of the television screen. The logos or video sequences are representative or indicative of the different products and/or services and/or companies corresponding to the different commercials which are available for display" (Balakrishnan [0018]) wherein the user is allowed to select advertising for viewing from the menu (Balakrishnan [0020]) and to skip forward past the menu (Balakrishnan [0020]). Therefore, the examiner submits that it would have been further obvious to one of ordinary skill in the art at the time the invention was made to modify the Gales bookending and the Audi bookend at the beginning and end of a commercial break combination with the Balakrishnan et al. menu for the purpose of further attracting a user's interest in viewing advertising by providing a viewer the interactivity of selecting an advertisement of interest for viewing and thus "involve viewers in an interactive way with commercials, [getting] them interested enough to stay with what is being presented longer" (Gales, see para. 3).

As to claim 14 , the claimed "wherein if said teaser is a menu then the viewer is allowed to skip forward past the menu or select a particular item via the menu" is met by the Gales, Audi and Balakrishnan combination as discussed in the rejection of claim 3 wherein "[t]he viewer can suitably use a remote control unit (RCU) or other user control device (e.g., programmable

keypad) to select the commercial he/he desires to view [from the menu]" (Balakrishnan [0020]) and "[t]he application program could be written to force the display of a default commercial in the event the viewer does not select any commercial within a predetermined default period of time (Balakrishnan [0020]), thus a user who waits until the predetermined default period of time has elapsed is allowed to skip forward past the menu.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gales Article: "Creatives find 'Bookends' a Solution to Viewer Apathy in further view of Automotive News: Audi Ads focus on technology, Balakrishnan et al. (US 2001/0052135 A1), and Geer et al. (US 6,788,882 B1)..

As to claim 15, the claimed "wherein the DVR pauses after displaying said teaser." Note the Gales Article discloses the use of bookended advertisement teasers to encourage users to watch a commercial break (see Excedrin Commercial Spot). The Gales Article also discloses "'[t]he [bookend] strategy is probably based on sound principles,' said Betsy Frank, senior vp/associate director of media research for Saatchi & Saatchi Advertising, 'that the more you can involve viewers in an interactive way with commercials, it gets them interested enough to stay with what is being presented longer'" (Gales, see para. 3). However, the Gales Article does not specifically disclose "wherein the DVR pauses after displaying said teaser." Now note the Balakrishnan et al. reference that discloses a method and system for implementing interactive broadcast programs and commercials wherein "at the time of a commercial break in the main program being broadcast over the broadcast channel which is currently selected by the viewer, a choice (or menu) or different commercials which are available to the viewer will be displayed. For example, several different logos or video sequences can be displayed on different portions or

spatial locations of the display area of the television screen. The logos or video sequences are representative or indicative of the different products and/or services and/or companies corresponding to the different commercials which are available for display" (Balakrishnan [0018]) wherein the menu is may be displayed for a predetermined default period of time (a pause) (Balakrishnan [0020]). Therefore, the examiner submits that it would have been further obvious to one of ordinary skill in the art at the time the invention was made to modify the Gales bookending and the Audi bookend at the beginning and end of a commercial break combination with the Balakrishnan et al. menu for the purpose of further attracting a user's interest in viewing advertising by providing a viewer the interactivity of selecting an advertisement of interest for viewing and thus "involve viewers in an interactive way with commercials, [getting] them interested enough to stay with what is being presented longer" (Gales, see para. 3). However, the Gales, Audi, and Balakrishnan et al. reference is silent as to a DVR. Now note the Geer et al. reference that discloses systems and methods for storing a plurality of video stream on re-writable random-access media and time-and channel- based retrieval thereof.

The claimed "DVR" is met by "[t]he digital video recorder of the present invention remedies the short comings of traditional video recording methods. The DVR does this by combining an essentially limitless (only limited by the cost of the equipment) capability concurrently to record a number of channels on a random-access medium while being able concurrently to play back any of these channels for viewing" (Geer 2:6-16). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gale, Audi, and Balakrishnan combination teaching pausing after displaying the menu with the Greer et al. DVR for the purpose of providing a viewing environment that offers

increased flexibility to a user in viewing programs aired over multiple channels (Geer 1:47-60). Note that the claimed "wherein the DVR pauses after displaying said teaser" is met by the Gale, Audi, Balakrishnan et al., and Geer et al. combination as discussed above.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Balakrishnan et al. (US 2001/0052135 A1) in further view of Geer et al. (US 6,788,882 B1).

As to claim 16, note the Balakrishnan et al. reference that discloses a method and system for implementing interactive broadcast programs and commercials. The claimed "designating a beginning portion of a commercial break in a program segment" is met by "at the time of a commercial break in the main program being broadcast over the broadcast channel which is currently selected by the viewer, a choice (or menu) of different commercials which are available to the viewer will be displayed. For example, several different logos or video sequences can be displayed on different portions or spatial locations of the display area of the television screen. The logos or video sequences are representative or indicative of the different products and/or services and/or companies corresponding to the different commercials which are available for display" (Balakrishnan [0018]). The claimed "wherein the beginning portion is of a predetermined length of time" is met by the menu being displayed for a default (predetermined) period of time (e.g. 15-30 seconds) (Balakrishnan [0020]). The claimed "wherein said beginning portion is authored to display a menu to a viewer" is met by "at the time of a commercial break in the main program being broadcast over the broadcast channel which is currently selected by the viewer, a choice (or menu) of different commercials which are available to the viewer will be displayed" (Balakrishnan [0018]). The claimed "pauses after displaying the menu" is met by the menu may be displayed for a predetermined default period of time (a pause) (Balakrishnan

[0020]). The claimed "wherein the viewer is allowed to skip forward past the menu" is met by "[t]he application program could be written to force the display of a default commercial in the event the viewer does not select any commercial within a predetermined default period of time (Balakrishnan [0020]), thus a user who waits until the predetermined default period of time has elapsed is allowed to skip forward past the menu. The claimed wherein the viewer is allowed to "select a particular item via the menu" is met by "[t]he viewer can suitably use a remote control unit (RCU) or other user control device (e.g., programmable keypad) to select the commercial he/she desires to view" (Balakrishnan [0020]). However, the Balakrishnan et al. reference is silent as to the use of a DVR. Now note the Geer et al. reference that discloses systems and methods for storing a plurality of video stream on re-writable random-access media and time-and channel- based retrieval thereof. The claimed "DVR" is met by "[t]he digital video recorder of the present invention remedies the short comings of traditional video recording methods. The DVR does this by combining an essentially limitless (only limited by the cost of the equipment) capability concurrently to record a number of channels on a random-access medium while being able concurrently to play back any of these channels for viewing" (Geer 2:6-16). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Balakrishnan pausing after displaying the menu with the Greer et al. DVR for the purpose of providing a viewing environment that offers increased flexibility to a user in viewing programs aired over multiple channels (Geer 1:47-60). Note that the claimed "wherein the DVR pauses after displaying the menu" is met by the Balakrishnan et al. and Geer et al. combination as discussed above.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (571) 272-7351. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm

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PRIMARY EXAMINER